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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,191	03/24/2004	Maria Theresa Barnes-Leon	OIC0100US	6005

60975 7590 01/22/2007		EXAMINER
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ART UNIT	PAPER NUMBER
2164	

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SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/809,191	BARNES-LEON ET AL.
	Examiner	Art Unit	
	Leslie Wong	2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>23 October 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>03/24/2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1.   Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C 101.

2.   Claims 1 and 12 recite, "... converting the enterprise information in the second intermediate form into a target form...", the claims appear to lack TANGIBLE results as it does not store the target form of data in a database or utilize the converted data to generate and display the converted/stored information. As such, the claims are not statutory because they merely recite a number of steps without producing any real world benefit or tangible result being limited to a practical application.

3.   Claims 4-11 and 13-20 recite the custom data type elements such as an address custom data type element, an auto deal custom data type element, a claim custom data type element etc... these data type elements are merely an arrangement of data which is nonfunctional descriptive material. As a result, 4-11 and 13-20 are not statutory.

MPEP § 2106.01 states:

Computer-Related Nonstatutory Subject Matter

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in

anticipation of applicant amending these claims to place them within the four categories

of invention.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

5.   Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by

Hellman et al. ("Hellman") (US 20030163597A1).

Regarding claims 1 and 12, **Hellman** teaches a method and computer-readable

medium in a computing system for managing enterprise data, the method comprising:

a).   extracting enterprise information in a first form that is associated with a

first source computerized system (¶s 0045, 0070, 0074);

b).   converting the enterprise information in the first form into corresponding

information that is in a second intermediate form (¶s 0058, 0059, 0074, 0198); and

c).   converting the enterprise information in the second intermediate form into

a target form that corresponds to a target computerized system, wherein the second

intermediate form includes a plurality of custom data type elements that are adapted for

capturing customer information and that can be referenced by other data structures in the second intermediate form (¶s 0048, 0071, 0074, 0198, 0202, 0390-0393), and wherein any modifications of the other data structures in the second intermediate form are independent of the custom data type elements (i.e., modifying the XML schema would not affect the data type elements – classes and attributes)(¶s 0195 and 0198)

Regarding claim 2, **Hellman** further teaches the steps of:

a).   extracting enterprise information in a third form that is associated with a second source computerized system that is distinct from the first source computerized system (¶s 0045 and 0074);

b).   converting the enterprise information in the third form into enterprise information that is in the second intermediate form (¶s 0198, 0200); and

c).   converting the enterprise information in the second intermediate form into the target form (¶s 0048, 0074).

Regarding claim 3, **Hellman** further teaches wherein the customer information includes information that defines specific aspects of the customer's business (¶ 0390).

Regarding claim 4, **Hellman** further teaches wherein the custom data type elements include one or more elements comprising: an address custom data type element; an auto deal custom data type element; an auto policy custom data type element; an auto sales history custom data type element; an auto service history

custom data type element; an auto service job custom data type element; an auto

service repair order custom data type element; a balance statement custom data type

element; a billing profile custom data type element; a bill of material component custom

data type element; a bill of material custom data type element; a business unit custom

data type element (¶s 0390 and 0393).

Regarding claim 5, **Hellman** further teaches wherein the custom data type

elements include one or more elements comprising: a claim custom data type element;

a claim payment custom data type element; a class attribute custom data type element;

a class attribute value custom data type element; a class custom data custom data type

element; a contact-of custom data type element; a contract custom data type element; a

cost list custom data type element; and a cost list line custom data type element (¶s

0390 and 0393).

Regarding claim 6, **Hellman** further teaches wherein the custom data type

elements include one or more elements comprising: a credit bureau report custom data

type element; a customer-of custom data type element; an employee-of custom data

type element; an expense custom data type element; an expense line custom data type

element; a financial account custom data type element; a financial applicant custom

data type element; a financial application account custom data type element; a financial

application collateral custom data type element; a financial application custom data type

element; a financial application funding source custom data type element; and a financial statement custom data type element (¶s 0390 and 0393).

Regarding claim 7, **Hellman** further teaches wherein the custom data type elements include one or more elements comprising: a forecast custom data type element; a forecast line detail custom data type element; a product catalog custom data type element; a product catalog line item custom data type element; a product custom data type element; a product inventory location custom data type element; a product line custom data type element; a product price custom data type element; an installed product custom data type element; a price list custom data type element; and a price list line custom data type element (¶s 0390 and 0393).

Regarding claim 8, **Hellman** further teaches wherein the custom data type elements include one or more elements comprising: a purchase order custom data type element; a purchase order line item custom data type element; a vehicle anti theft device custom data type element; a vehicle custom data type element; a vehicle option custom data type element; a person custom data type element; a policy custom data type element; a position custom data type element; a related-to custom data type element; a represented-by custom data type element; a security custom data type element; a service request custom data type element; and a set of books custom data type element (Appendix A, page 29, ¶s 0390 and 0412).

Regarding claim 9, **Hellman** further teaches wherein the custom data type

elements include one or more elements comprising: an order custom data type element;

an order line custom data type element; an order type custom data type element; an

organization custom data type element; a party authentication custom data type

element; a party custom data type element; a payment custom data type element; a

payment line custom data type element; a payment method custom data type element;

a payment term custom data type element; and a payment type custom data type

element (¶s 0390 and 0393).

Regarding claim 10, **Hellman** further teaches wherein the custom data type

elements include one or more elements comprising: an opportunity custom data type

element; an opportunity notes custom data type element; an opportunity revenue item

custom data type element; an invoice custom data type element; an invoice line custom

data type element; an invoice plan custom data type element; an invoice type custom

data type element; a life policy custom data type element; and a list of relationship

custom data type element (¶s 0390 and 0393).

Regarding claim 11, **Hellman** further teaches wherein the custom data type

elements include one or more elements comprising: an inventory balance custom data

type element; an inventory balance list of balance balance custom data type element;

an inventory transaction custom data type element; an inventory location custom data

type element; a functional area custom data type element; a holding custom data type

element; and a household custom data type element (¶s 0390 and 0393).

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

7.   Claims 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Hellman et al. ("Hellman") (US 20030163597A1).

Regarding claims 13-20, they may include limitations not covered in the prior art; however, these elements are data structures per se, the data and software structures are considered to be non functional data and are considered to be *directed to data Per Se*. Thus, the difference is limited to non-functional descriptive material stored on a machine which cannot render an invention non-obvious for an invention that would otherwise have been obvious (see MPEP 2106 IV B 1 (b) and 2126 VI). The fact that the data can be recalled does not make it functional.

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
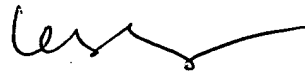
Alam et al. (U.S. Patent 6,336,124 B1) teaches conversion data representing a document to other formats for manipulation and display.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (571) 272-4120. The examiner can normally be reached on Monday to Friday 9:30am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES RONES can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Leslie Wong
Primary Patent Examiner
Art Unit 2164

LW
January 17, 2007